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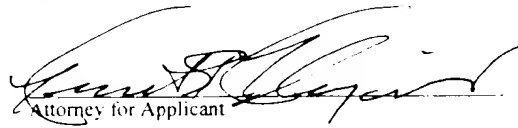
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert B. Harkness and Philip A.
Harkness
Application No. 09/255,107

Art Unit: 1661

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on March 27, 2002 as First Class Mail in an envelope addressed to BOX NON-FEE AMENDMENT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231.


Attorney for Applicant

Filed: February 22, 1999

For: CLIMBER ROSE PLANT NAMED HARYUP

Examiner: Howard J. Locker

Date: March 27, 2002

BOX NON-FEE AMENDMENT
COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

AMENDMENT

Responsive to the Office Action of December 27, 2001, reconsideration of the application and withdrawal of the rejection thereof are respectfully requested for the reasons set forth below.

**PUBLICATION OF HARYUP BREEDER'S RIGHTS APPLICATIONS AND GRANTS
WOULD NOT ENABLE ANYONE TO PRODUCE THE PLANT AND THUS ARE NOT
'ENABLING' PUBLICATIONS UNDER 35 USC § 102(b)**

Although the Examiner admits in the Action that "[t]he text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention." (Action, page 4), the claim is rejected under 35 USC § 102(b) on the ground that because the plant of the application was on sale in foreign countries more than one year prior to the filing date of the application, the publications become enabling because "the disclosed cultivar could have been propagated from publicly available materials." This is clearly contrary to the law as set forth in In re LeGrice, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) and is a rejection not authorized by the MPEP.

The court in LeGrice simply and plainly held that a description of a plant "just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in possession of those so skilled." (133 USPQ @ 378). In other words, that by reason of the description and some magic, then and now not known, a person of ordinary skill in the art could reproduce the plant of the publication. It didn't hold that a publication of a plant coupled with knowledge that a plant was available in a foreign country and could be asexually reproduced if any part of the such plant could be obtained would bar a patent, but rather that the description and as yet unavailable skills together must be sufficient to enable one to reproduce the plant of the description by some means other than asexual reproduction of the plant of the publication.

This is clearly indicated in the opinion where the court after discussing how new varieties are hybridized by sexual propagation and new varieties reproduced by asexual reproduction (133 USPQ at 372-373), discusses why the printed publications relied upon in rejection of the applications at issue could not be relied upon as a statutory bar, to wit:

While the present knowledge of plant genetics may mean as a practical matter, that the descriptions in such general publications as are here involved cannot be relied upon as a statutory bar under section 102(b), we must be mindful of the scientific efforts which are daily adding to the store of knowledge in the fields of plant heredity and plant eugenics, which one skilled in this art will be presumed to possess. (133 USPQ at 374)

⁷ While many such studies undoubtedly are in progress, some idea of the possible additions to the knowledge of plant heredity is found in current seed catalog offerings of peanut seeds which by atomic irradiation will produce plants in which the peanuts are produced above the ground. The chemical colchicine also is widely used to modify genetic characteristics of seeds. Current studies to "break the chromosome code" may also add to the knowledge of plant breeders so that they may someday secure possession of a plant invention by a description in a printed publication as is now possible in other fields of inventive effort.

The absurdity of the position that is advanced in the Action becomes apparent if it is considered in light of a non-enabling publication of a mechanical product in some foreign country. Under the position advanced in the Action such a publication becomes enabling if that product is on sale in a foreign country. The undersigned is not aware of any decision, by a Court or Patent Office body, which even suggests such a position. To the contrary a foreign sale is not prior art under Section 102.

It is asserted in the Action (page 4) that applicant's contention the court in LeGrice "knew the plant was on sale" is not borne out by the record. This assertion is wholly incorrect. The Transcript of Record in LeGrice clearly shows that in the decision of the Board of Appeals, February 12, 1960, appealed to the Court, the Board specifically found "(t)he publications (which were the basis for rejection of the LeGrice applications) indicate that the particular plants were on sale (in England), and presumably also in public use, more than one year prior to the respective filing dates of the (appealed) applications..." (Emphasis added). (See page 22, Exhibit A to Amendment of August 3, 2001).

The LeGrice Board properly noted the fact of sale or public use in England to be "irrelevant" (LeGrice Record, p.25) to the "issue of the competency of a prior printed publication to bar a plant patent..." (LeGrice Record, p. 22). The Court's obligation was to consider the correctness of the Board's decision and in doing so had to review the Board's stated basis for its holding. If the LeGrice Court had felt that the fact the roses at issue were "on sale" in England was relevant, it would have said so! It is significant that it did not.

The LeGrice Board held that the publications were a bar to the granting of patents on the two rose varieties of the appealed applications "because the reference publications in these cases adequately identify the claimed plants..." (LeGrice Record, p. 27), but the LeGrice court firmly rejected the Board's holding:

The descriptions of the new roses in the instant publications*, are incapable of placing these roses in the public domain by their descriptions when interpreted in the light of the knowledge now possessed by plant breeders. The roses disclosed in the appealed applications are not, therefore, "described in a printed publication" within the meaning of 35 U.S.C. 102(b).

The decision of the Board of Appeals is *reversed*. 133 USPQ at 378. (Emphasis in original).

*(Footnote omitted)

Significant is what the LeGrice Court did not hold, namely, that the publications were enabling because the plants were on sale in England. If the Court had thought the LeGrice Board should have not considered evidence of sale to be irrelevant it would have said so.

The precedent of LeGrice should be controlling here.

The LeGrice Court stated its view of the law regarding publications as anticipating art as follows:

We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. (Emphasis in original.) 133 USPQ at 372.

In other words, the publication would have to enable a person skilled in the art to reproduce the rose described therein without more than such persons own knowledge. The fact of the matter is that even as of today no one can. The only known way of reproducing a rose (or any other plant protectable by plant patent) is by asexual reproduction of the plant which requires acquisition of some part of the plant. If the existence of a plant is published in a catalogue and the plant offered for sale in a foreign country it could still only be reproduced in the United States by bringing at least a part of the plant into the United States and reproducing the plant

asexually from such part! Such reproduction is not because of information obtained from a disclosure and the application of skills of an artisan such as contemplated by the LeGrice court!

The LeGrice Court stated its interpretation of an "enabling" description as follows:

Our study of the prior cases which have imposed this interpretation on the clause indicates that the proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought. Unless this condition prevails, the description in the printed publication is inadequate as a statutory bar to patentability under section 102(b). LeGrice, 133 USPQ at 373-374.

The Court's requirement is that the publication and the skill be such as to permit one to reproduce the invention without recourse to the plant if it is the "invention." It did not mean that if a plant described in a publication were available in a foreign country and could be obtained and asexually reproduced that this automatically made the printed publication "enabling." The publication would not, in fact, enable such reproduction nor would the asexual reproduction be affected in any way by the publication.

The fact of the matter is that offers for sale or sales in a foreign country in no way "enable" a written publication describing a plant. They are two separate, independent events that do not cooperate to put the plant in the public domain in the United States.

A third party having knowledge of foreign sales of a variety would not be assisted in its reproduction in the United States or elsewhere by reason of the publication of a breeders' rights application or the issuance of a grant in some foreign country even if such person were aware of the publication or grant.

The theory that a publication describing a variety is made enabling by a foreign sale of such variety is not in accordance with the law and is not sustainable under any theory.

If the theory that the ability of someone to propagate "from publicly available materials" a rose or other asexually reproducible plant makes such plant ineligible for patent protection, the mere fact of evidence of sale of a plant in a foreign country would be a basis for holding that such plant was ineligible for patent protection in the United States. There would be no need for a publication describing that plant. This of course is not the law since Section 102 requires that the sale has to be "in this country."

The Examiner argues (page 4) that "the Board in Thomson felt there was no evidence of sale in LeGrice." The Record in LeGrice shows this was in error since the "Decision of Board of Appeals, February 12, 1960," which was appealed to the Court contains the explicit conclusion of the Board "that the particular plants were on sale, and presumably also in public use more than one year prior to the respective filing dates. . . ." (See Exhibit A, p. 22 to Amendment filed September 24, 2001). The Thomson Board obviously did not review the LeGrice Record or it would not have contended there was no indication in LeGrice supporting commercial availability since the fact of sale was clearly in the LeGrice Record and was given no weight by the LeGrice court!

**RECORD IN IN RE LEGRICE CLEARLY ESTABLISHES
ROSE CULTIVARS OF APPLICATIONS ON APPEAL WERE "ON SALE"
AS BOARD SPECIFICALLY FOUND.**

On page 6 of the Action, the contention is made that the argument that the plants in LeGrice were on sale "is not persuasive because in LeGrice, applicant never admitted that the rose cultivar was on sale anywhere. Instead, applicant stated 'Prior public use or sale are the avenues by which a plant enters the public domain.' (LeGrice, p. 372 (sic))." This statement, (@ LeGrice p. 371) taken by the Court from LeGrice's Brief of Appellant, was not a denial the plants of the applications were on sale. It was the conclusory sentence of a paragraph beginning

on page 7 of the Brief of Appellant to the Court, wherein it is pointed out that a publication describing a plant cannot enable others to reproduce the plant and "cannot take from the public that which had long before been invented and, by publication, placed in public domain. Prior public use and sale of a plant are the avenues by which a plant enters the public domain." See Exhibit A attached hereto.

This was not a denial that the rose plants of the appealed applications were "on sale" in England, but was made in rebuttal to the contention of the Board that the publications and catalogues were enabling and placed the plants in the public domain.

The Examiner contends (page 6) that applicant's contention the LeGrice Court knew the plant had been on sale and found that fact irrelevant is contrary to the written opinion of the Court. Applicant's contention is not contrary. The LeGrice Court was considering an appeal from the decision of the Board upholding the rejections of two applications based upon publications illustrating the roses of such applications. The Court necessarily had to review the opinion of the Board to determine whether the Board's affirmance should be affirmed or reversed. The Board's opinion clearly stated its conclusion the plants were on sale and it does injustice to the Court to conclude that it ignored this finding of the Board. If the Court had deemed the fact of sale to have made the publications "enabling," it surely would have done so but obviously it deemed the fact of sale to be "irrelevant" as did the Board, and proceeded to declare the publications not to be enabling and reversed the Board.

The Examiner argues (page 5) that the rejection herein is based only upon a printed publication, but it is admitted in the Action that such publication "would not have enabled one skilled in the art to practice the claimed invention." This is absolutely correct. The invention can only be practiced by asexual reproduction of actual plant material and the availability of plant material somewhere else in the world does not make it possible to reproduce the invention

from information gleaned from the publication. This was the issue considered in LeGrice which reversed the rejection of the two applications on appeal on the ground the publications were not enabling, and did so in the face of the Board's finding the plants of the application were "on sale."

Applicant is not attempting to create a geographic component of enablement as contended by the Examiner, but rather desires to have this application treated as the controlling authority so clearly indicated in LeGrice how it should be treated with the facts as they are.

Ex Parte Rhinehart is not relevant.

That decision merely held that it was not necessary for a deposit to be made of the starting material for a process. No question of enablement was present in that case.

The Examiner also argues that applicant's argument Thomson is contrary to law and is not persuasive. But the holding in Thomson is clearly contrary to the LeGrice decision wherein the identical facts were present, namely, a non-enabling publication plus evidence of foreign sale. The Board in Thomson clearly made a decision that is contrary to what should have been the controlling decision, In re LeGrice.

**THE REJECTION HEREIN UNDER SECTION 102, IS NOT
AUTHORIZED BY AND IS CONTRARY TO THE MANUAL OF PATENT
EXAMINING PROCEDURE AND TO THE LAW**

The MPEP expressly provides: "...for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claim invention, either explicitly or implicitly." (MPEP 700-10).

In the *Foreword* of the MPEP it is stated, inter alia, that it "outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application." (Emphasis added). The rejection in the subject application under Section 102(b) based upon two events, (1) a publication and (2) a foreign sale,

is clearly not authorized by the MPEP and should be withdrawn. It is admitted in the Action that "(t)he text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention." That admission perforce establishes the wrongfulness of using the publications as a basis for a rejection in the face of MPEP 700-10. None of the PBR publications relied upon "teach every aspect of the claim" and are clearly not a basis for a rejection under Section 102(b).

Moreover, use of combined references in a Section 102 rejection is contrary to the law as established by the Court of Appeals, Federal Circuit which has explicitly declared that: "...one who seeks such a finding (anticipation under 35 U.S.C. 102) must show that each element of the claim in issue is found, either expressly described or under principles of inherency, in a single prior reference..." (Emphasis added). Kalman v. Kimberly-Clarke Corp., 713 F2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983). Thus, it is clearly improper to base the rejection of the claim of the subject application on the publication of a prior breeder's rights application and/or grant, which it is admitted, did not enable "one skilled in the art to practice the claimed invention," and the fact that the plant of the application was offered for sale outside of the United States more than one year prior to the subject application. Only by securing a portion of the actual plant material and asexually reproducing such portion could the plant HARYUP be reproduced. Thus practice of the invention is enabled, not because of the PBR publications, but only through procurement of actual plant material.

PUBLIC USE OR SALE MUST BE IN THE UNITED STATES

The reliance upon the availability of the plant of the application in some foreign country more than one year prior to the date of the application is also contrary to Section 102 of the patent law. The pertinent part of that section reads as follows:

§ 102: Conditions for Patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless...(b) the invention was...in public use or on sale in this country more than year prior to the date of the application for patent in the United States. (Emphasis added).

The sale of HARYUP plants in a foreign country is clearly irrelevant under § 102 and is not relevant under any other Section of the Patent law.

On pages 5-6 of the Action, it is stated "(f)urthermore the Examiner acknowledges that a foreign use or sale, undocumented by a patent or printed publication, is not a statutory bar under 35 U.S.C. 102." Even if documented by a patent or printed publication the sale would not be a bar! The patent or publication, if enabling by itself and more than one year before the U.S. application would be relevant prior art, but the sale itself would be irrelevant. Other than wrongfully decided Ex parte Thomson, the undersigned is not aware of any case, Board or Court, wherein it was held that a non-enabling publication is rendered enabling because of evidence of foreign sale of the subject of the publication.

COOPER, BIOTECHNOLOGY AND THE LAW, NOT RELEVANT

The Examiner also makes reference to Cooper, Biotechnology and The Law, Section 8.05 (1998 Clark Boardman Callaghan) and quotes the following sentence: "In essence, then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public." (Emphasis in quotes). This statement is only partially accurate and omits the fact that the availability has to be within the United States pursuant to Section 102, and meet the "in public use or on sale" requirement of the statute and which latter event also must be more than one year prior to the date of the

application. Either the public use or on sale event would trigger Section 102(b) if more than one year prior to the application and the fact of a public description would have no relevance. In any event the Cooper reference provides no basis for the rejection of the subject application.

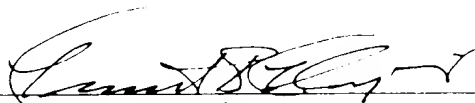
CONCLUSION

It is clear that the rejection of the claim of the subject application is contrary to the patent law as established in LeGrice, is not authorized by the MPEP and should be withdrawn. A Notice of Allowance should be issued herein and such is respectfully requested.

Respectfully submitted,

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